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Supreme Court of the United States

OCTOBER TERM 1930

No. 46

LOUIS H. ENSTEN and LION KNITTING MILLS COMPANY,

Petitioners,

against

SIMON ASCHER & CO., INC.,

Respondent.

BRIEF ON BEHALF OF RESPONDENT

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BRIEF ON BEHALF OF RESPONDENT.

This case comes before this Court on a writ of certiorari to the Circuit Court of Appeals for the Second Circuit.

The writ was granted on the ground that there was diversity of decision between the Circuit Courts of Appeals for the Second and the Seventh Circuits.

The question presented for decision is whether the plaintiff below, by the filing of a disclaimer after a delay of nearly two years after an interlocutory decree of the Ohio District Court, declaring invalid claim 2 of the patent in suit, has brought himself within the provisions of Revised Statutes, Sections 4917 and 4922 (35 U. S. C. A., Sections 65 and 71), so as to be entitled to maintain a suit in equity for the infringement of other claims of the patent.

According to the Circuit Court of Appeals for the Second Circuit, there is diversity of views on this question between the two Circuit Courts of Appeals.

The Facts.

On May 24, 1922, in *Ensten* v. *Rich Sampliner Company, et al.* (unreported), in the United States District Court for the Northern District of Ohio, Eastern Division, Judge WESTENHAVER entered an interlocutory decree holding claims 1, 3, 4 and 5 of the patent valid and infringed; and holding claim 2 invalid. (See 291 Fed. 1003.)

On June 10, 1922, appeal was taken by the defendants in that suit from the portion of the decree holding claims 1, 3, 4 and 5 valid and infringed.

No appeal was ever taken by the plaintiff from the portion of the decree holding claim 2 invalid.

On June 20, 1923, the Circuit Court of Appeals for the Sixth Circuit filed an opinion (291 Fed. 1003) affirming the District Court, but, of course, did not pass upon the validity of claim 2, as it was not before the court.

The case went to an accounting and during the accounting the plaintiff attempted to prove loss of profits and damages to his alleged exclusive licensee, Lion Knitting Mills Company. The Master rejected the proof because the Lion Knitting Mills Company was not a party plaintiff in that suit. The District Court affirmed this ruling.

Subsequently, on April 30, 1924 (nearly two years after the entry of the interlocutory decree holding claim 2 invalid), a disclaimer of claim 2 was entered in the Patent Office by the plaintiff.

Thereafter, plaintiff, together with the Lion Knitting Mills Company as a party plaintiff, filed a new bill in the same Court, against the same defendants.

Defendants moved to dismiss upon the ground that the suit could not be maintained because the entering of the disclaimer had been unreasonably neglected or delayed.

As a result of this motion a decree was entered dismissing the bill; and an appeal was taken.

The Circuit Court of Appeals for the Sixth Circuit did not pass upon the question of whether the entry of the disclaimer had been unreasonably neglected or delayed, as it found that the new bill was in the nature of an amendment to the original bill and held that the question was therefore moot.

The District Court was reversed solely upon the ground that the new bill should have been treated as an amendment to the original bill.

Thereafter, on November 1, 1928, the final decree was entered in the original suit and settlement was made by the defendant in that case.

This was the state of the patent when the instant suit was commenced on November 9, 1929, in the District Court for the Southern District of New York.

On motion of defendant, this suit was dismissed because the entry of the disclaimer had been unreasonably neglected or delayed, following the opinion of Judge WESTENHAVER in the second suit in the Ohio District.

Upon appeal, the District Court for the Southern District of New York was affirmed on the authority of the Hoe Case, in the Second Circuit Court of Appeals; and the case is here on certiorari to that decree.

The petitioner here was the plaintiff below, and the respondent here was the defendant below.

In this brief, we will speak of the petitioner as the plaintiff, and of the respondent as the defendant.

The plaintiff contends here:

1. The disclaimer was filed in time.
2. The filing of the disclaimer has nothing to do

with the validity of the patent in suit as to claims 1, 3, 4 and 5, and relates only to costs.

We will consider these points in this order.

POINT I.

The entering of the disclaimer in this case was unreasonably delayed and the plaintiff lost the right to amend the patent, and to maintain a suit thereon for infringement.

Under the common law, and, as well, under the Patent Act of 1793, a patent was *void* when it was made to appear that the thing secured by the patent was not originally discovered by the patentee. The patentee can lawfully claim only what he has invented and described, and if he claim more, his patent is void. *O'Reilly* v. *Morse*, 15 How. 62, 121.

Under the Patent Act of 1836 it is provided that "judgment shall be rendered for the defendant with costs" when it shall have been made to appear "that the patentee was not the original and first inventor or discoverer of the thing patented *or of a substantial and material part thereof*". (Italics ours.)

By the reissue statute (enacted in 1832), such void patents could be surrendered and reissued for the true invention, thus eliminating the excess. But all rights prior to reissue were forfeited by the surrender.

The disclaimer statutes were enacted, in 1837, to provide an inexpensive and expeditious method of promptly removing the defect of excessive claiming; and, at the same time, to avoid the defense on this ground.

The disclaimer statutes, originally enacted as Sections 7 and 9 of the Patent Act of 1837, are substantially now reenacted as Revised Statutes, Sections 4917 and 4922.

Section 4917 provides a method of amending a defective patent.

Section 4922 provides a method of avoiding the defense of excessive claiming and permits the maintaining of a suit for infringement, provided a disclaimer is seasonably entered in the Patent Office. *Robinson on Patents*, Vol. 2, Sec. 640, p. 279, Ed. of 1890.

The defense of excessive claiming still exists, but the disclaimer statute provides the means of avoiding it, by *promptly* amending the patent. If the disclaimer has been entered without unreasonable delay, the defense falls by virtue of these statutes. *Robinson on Patents*, Vol. 2, Sec. 651, pp. 292-293, Ed. of 1890.

History of the Disclaimer Statutes.

Under the Act of 1837, in Section 7, it was provided that where, without fraud, there is excessive claim, "but some material or substantial part of the thing patented" truly belongs to the patentee, such patentee may disclaim the excess. Such disclaimer shall thereafter be taken and considered a part of the original specification. "But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing the same."

Section 9 provided that whenever, without fraud, there is excessive claim "of any material or substantial part of the thing patented, of which he was not the first and original inventor", in every such case "the patent shall be deemed good and valid for so much of the invention or discovery as shall be truly and *bona fide* his own", provided the true invention shall be "a material and substan-

tial part of the thing patented, and be definitely distinguishable from the other parts so claimed".

And such patentee "shall be entitled *to maintain* a suit" on such patent for infringement of the true invention, notwithstanding the excessive claim, provided he has not unreasonably neglected or delayed to enter disclaimer. "Where, therefore, the patent is illegal in part because he claims more than * * * he invented, he must * * * disclaim, in order to save the portion to which he is entitled * * *". *O'Reilly* v. *Morse*, 15 How. 62, 121.

Sections 4917 and 4922 of the Revised Statutes (U. S. C. A., Title 35; Secs. 65 and 71) embrace all of the provisions of the two sections of the Act of 1837, but in somewhat different order.

Section 4917 contains all of the provisions of Section 7 of the Act of 1837, and, in addition, the opening clause of Section 9 of that Act, which provided that a patentee who, without fraud, makes excessive claim, may have a valid patent for all that part which is truly and justly his own, providing it is "a material or substantial part of the thing patented".

Section 4922 contains all of the provisions of Section 9 of the Act of 1837, except the first clause thereof, as above stated.

So it would seem that all of the provisions of Sections 7 and 9 of the Act of 1837 are present in Sections 4917 and 4922 of the Revised Statutes, the only difference being that the first clause of Section 9 is joined with Section 7 under Section 4917, and all the remaining clauses of Section 9 of the Act of 1837 constitute Section 4922.

The Effect of These Statutes.

It would seem that prior to the disclaimer statutes of 1837, it was the law that the whole patent was void if there was an excessive claim. It could be cured only by a reissue, and even this remedy was not available until 1832.

By the disclaimer statutes of 1837 and, as well, by the continuing disclaimer statutes to date, the effect of an excessive claim may be overcome by a proper disclaimer, but it must be seasonably filed. The statutes attach a condition that the plaintiff may not maintain a suit on the valid portions of his patent if he has unreasonably delayed in the filing of a disclaimer.

Under the cases, the disclaimer statutes must be read together. As we read these statutes, they mean that the patent containing the excess claim may be amended by disclaimer so as to be valid for the true invention, in spite of the excess; but if a disclaimer is not filed within a reasonable time, the patentee's action is equivalent to a fraudulent assertion of the excess, and his failure to file seasonably becomes a defense equal to the defense of fraudulent claiming. The patentee may initiate his action and maintain it so long as he is not *unreasonably* delaying in the filing of the disclaimer; but if the delay becomes unreasonable, it amounts to an assertion of the excess subsequent to knowledge of the excess; and that delay can be set up and may constitute a defense to the action.

The provision that no patentee shall be entitled to the benefits of Section 4922 if he has unreasonably neglected or delayed to enter a disclaimer means that as soon as the unreasonable character of the delay is apparent, the patentee has lost his right to amend his defective patent and to avoid the defense of excessive claiming; and that defense is then effective and complete.

Possibly nowhere has the meaning of these statutes been so succinctly stated as by Mr. Justice BRADLEY in *Hailes* v. *Albany Stove Co.* (1887), 123 U. S. 582, 588, where he says:

> "We think that counsel is mistaken in supposing that these sections have reference to different sets of circumstances as grounds for a disclaimer. They both relate to the same condition of things in that regard, namely, to the case in which a patentee, through inadvertence, accident, or mistake, and without any fraudulent intent, has included and claimed more in his patent than he was entitled to, and where the part which is *bona fide* his own is clearly distinguishable from the part claimed without right. In every such case he is authorized by section 4917 to file a disclaimer of the part to which he is not entitled; and that is the only section which gives him this right. The object of the other section (4922) is to legalize and uphold suits brought on such patents as are mentioned in section 4917, to the extent that the patentees are entitled to claim the inventions therein patented; but no costs are allowed to the plaintiffs in such suits unless the proper disclaimer has been entered at the patent office before the commencement thereof; and no patentee is entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer.
>
> We do not see how it is possible to misunderstand the two sections when read together, as it is necessary to read them. One section authorizes a disclaimer to be filed in certain cases; the other enables patentees to maintain suits in those cases, provided a disclaimer is filed without unreasonable delay. They are parts of one law, having one general purpose; and that purpose is to obviate the inconvenience and hardship of the common law, which made a patent wholly void if any part of the invention was wrongfully claimed by

the patentee, and which made such a defect in a patent an effectual bar to a suit brought upon it."

The Question Under Point I.

The question here is whether the owner of the patent in suit has brought himself within the provision of Rev. Stat. Section 4922, so as to "be entitled to the benefits of this section", since he did not file a disclaimer until April 30, 1924, which was nearly two years after claim 2 of the patent in suit had been declared invalid by the interlocutory decree of the District Court of Ohio on May 24, 1922. (See 291 Fed. 1003.)

Our contention is that when an excessive claim appears in any patent, the owner is *immediately* under obligation to disclaim, *unless* he is then engaged in prosecuting a suit to sustain the validity of such claim along *the most expeditious line reasonably open* that the law permits. The continuity of his effort is broken if he does not take the first available line that the law allows. He cannot, as in this case, forego the *right* to appeal from the interlocutory decree, and continue to assert his claim to a declared excessive and invalid claim for nearly two years. If he does, he loses the right to amend the patent and to maintain a suit on the valid claims thereof.

Can the plaintiff now "maintain a suit" under Rev. Stat. Section 4922? For it is only by the provisions of this section that he can maintain this suit.

Claim 2 of this patent was held invalid by the interlocutory decree of the Ohio District Court on May 24, 1922. From this decree no appeal was ever taken. A disclaimer was filed nearly two years later, but before final decree in that case.

Has the plaintiff here broken the continuity of his effort to prosecute his claim under *all* the statutes?

We think he has.

In the absence of the disclaimer statutes, this patent is void because of the excessive claim. No suit can be maintained on it unless the disclaimer has been entered without unreasonable delay. Knowingly to persevere in an excessive claim is equivalent to an original fraudulent insertion of such excess. Such original fraud is an incurable vice.

Robinson says:

> "The defect which a disclaimer is intended to remove is one that, in its nature, is fatal to the patent. An inventor has no more right under the modern law than he had under the ancient law to claim what he has not invented, and thus deprive the public of their vested privileges. Knowingly to insert such Claims in his original patent is a fraud which invalidates his grant, and knowingly to persevere in them, after he has discovered that they are without foundation, is a fraud which *forfeits all his rights* to the protection of any part of the invention covered by the patent. In cases of excessive Claim *an amendment by disclaimer* or re-issue *is thus necessary* to save any portion of the privilege conferred by the patent; and at whatever period, during the life of the patent, the patentee becomes aware of this defect he must remove it or the value of his patent is destroyed. (Robinson on Patents, Vol. 2, Sec. 642, pp. 280, 281.) (Italics ours.)

When the owner discovers the excess, his obligation to disclaim arises. To unreasonably delay thereafter is to forfeit the rights granted under the disclaimer statute.

> "An excessive Claim can be amended by disclaimer only when the amendment is attempted without unreasonable delay. The same principle which forbids a patentee to assert a right to more than he has actu-

ally invented compels him to disavow the right *as soon* as he discovers that it has been unjustly claimed. Unreasonable delay in disclaiming is thus tantamount to an original fraudulent Claim, and through it the patentee loses the privilege of making the amendment by which alone his patent could be saved." (Robinson on Patents, Vol. 2, Sec. 646, p. 284.) (Italics ours.)

Delay begins whenever the patentee becomes aware that he is not the first inventor.

"The question of unreasonable delay is a question for the court, upon the facts as found either by its own investigation or the verdict of a jury. Delay begins whenever the patentee becomes aware that he has claimed more than he has invented or described. In cases where the excess is not apparent at once upon the inspection of the patent by the patentee, the allowance of his Claim by the Patent Office raises such a presumption in its favor that he may rely on its validity until a court of competent jurisdiction decides that it is broader than his real invention." (Robinson on Patents, Sec. 646, Vol. 2.)

In *Singer* v. *Walmsley* (1860), 1 Fisher, 558, 22 Fed. Cas. 207, GILES, *J.*, said (575):

"What is 'unreasonable delay' is a question to be settled by the court and not for the jury * * *. The court will find that the time, in reference to the question of delay, commences when the knowledge was brought home to the party that he was not the first inventor, or when it is declared by a court, of competent jurisdiction to settle the question, that he was not the first inventor; then it is that the time commences to run, and not until then."

As appears from the case of *O'Reilly* vs. *Morse* (1853), 15 How. 62, the plaintiff does not have to disclaim while

he is diligently prosecuting his appeal. He may await until the highest Court to which it can be carried has pronounced judgment. But that case cannot be considered as having devitalized the disclaimer statutes. In that case the claim had been held invalid in the lower court, and the Supreme Court was merely saying that if the plaintiff is in good faith prosecuting his appeal, he need not disclaim "until the highest court to which it could be carried" had passed judgment.

This, certainly, is no justification for contending that the plaintiff can delay until *final* decree in the District Court before taking the case to the highest court to which he had the *right* to go. At that time (1853) there was no appeal from the interlocutory decree. So the question of the unreasonableness of the delay after the interlocutory decree could not come up. The plaintiff had the right to appeal; and so long as he took the first open line of procedure, he could not be said to have delayed *unreasonably.*

But what of the case after he is given the right of appeal from the interlocutory decree?

According to Robinson—and to the rationale of the subject—the delay begins as soon as the patentee learns of the excess. The question as to the *reasonableness* of the delay depends on the circumstances. If he intends to insist on the validity of the claim declared to be excessive, he has a line of procedure open to him. If he does not follow it, he is knowingly persevering in a declared invalid claim during a period when he, alone, can bring this question to the "highest court", and does not. Is not the delay occasioned by such a perseverance in a claim declared not to be his, a delay that requires explanation and justification? Can he be said to be diligently and continuously attempting to obtain a determination of the validity of his

claim? And is it not possible, if he is not required to appeal by the first open line, to so persist in this declared invalid claim over a long period (in the instant case, nearly two years), with no intention of appeal from the final decree?

In the instant case, the plaintiff disclaimed before the final decree, possibly with the thought of its effect on a case then to be brought. But for nearly two years he had delayed in his disclaimer, and was, therefore, improperly persevering in the invalid claim. He took the chance of this delay being declared unreasonable. He was oppressing the public during all this time, apparently with no intention of appealing from the final decree. This delay was unreasonable. He has not complied with the provisions of Section 4922, and he cannot maintain this suit.

Answer to the Contention That the Appeal Statutes Govern This Point.

It is urged in behalf of the plaintiff's position that the right to appeal after interlocutory decree is merely permissive, and that since the right to appeal remains until after final decree in the District Court, the obligation to disclaim is held in abeyance until then, even though the plaintiff knows of the excessive nature of his claim and neglects to take the first open line of procedure to have the determination of the interlocutory decree set aside.

Must the appeal statutes be construed so as to defeat the purpose of the disclaimer statutes? We think not.

It must be borne in mind that without the disclaimer statute there is no right to maintain *any* suit on the excessive patent.

It is true that the appeal statutes provide for the appeal from either the interlocutory or final decree. But it

is equally true that, for the purposes of this discussion, the right of appeal after interlocutory decree gives to the plaintiff all the rights of the appeal from the final decree. In this respect the interlocutory decree is the law of the case until set aside by a reviewing court. The appeal from the final decree is really an appeal from the effect of the interlocutory decree, so far as we are here concerned. So what the plaintiff is here contending for is a mere form.

But the law makes this patent entirely void unless a disclaimer is filed seasonably. The plaintiff is faced with the necessity, after the finding of invalidity, either of promptly prosecuting his litigation along a line giving him the fullest protection to which he has a *right*, or of disclaiming. Is he maintaining the continuity of his effort, in good faith, when he neglects the first open line to a complete legal remedy, and elects to await idly the same remedy after a period of inactivity, so far as this right is concerned, that may amount to two, four, or even six years of accounting on an entirely different phase of the case?

And all this in the face of the policy of the law that gives him a right to maintain a suit only if he move with reasonable dispatch.

It does not seem to us that the cases, cited in the opposing briefs, on the right of appeal have application to this controversy.

As was said by the Court in *U. S.* vs. *American Bell Telephone Co.*, 167 U. S. 224:

> "A party seeking a right under the patent statutes may avail himself of *all* their provisions * * *."

But it is equally true that he takes with *all* the burdens imposed by these statutes. If he is insisting on the right

to maintain a suit on an otherwise unenforceable patent, he must comply with the provisions of the statute creating that right. And it does not seem to us that there is anything in any of the cases cited to the contrary.

The case of *Abercrombie & Fitch* vs. *Baldwin*, 245 U. S. 195, is referred to as, impliedly, declaring the law to be contrary to defendant's position here. An inspection of the facts shows this not to be true.

The decree of the Third Circuit Court of Appeals declaring the one claim in issue invalid was handed down January 22, 1915. Less than a month later, the District Court for the Southern District of New York filed its opinion, referring to the case in the Third Circuit Court of Appeals, but refusing to follow it, and upholding the same claim.

Here the plaintiff had, within one month, two decisions—the first, unfavorable; the second, favorable. Under these conditions, could a delay in disclaiming be said to be unreasonable? We think not. In the Second Circuit, the claim was valid until the District Court was reversed. As a matter of fact, the claim was upheld in that Circuit Court of Appeals and in the Supreme Court.

Certainly, under these conditions, there was no unreasonableness in delaying the filing of the disclaimer. Within a month, there was actually a difference of decision in two Circuits. While it is true the Second Circuit Court of Appeals did not hand down its decision until ten months after the Third Circuit Court of Appeals decision, it is a fact that the District Court of the Southern District of New York found the claim valid in the face of the contrary decision of the Third Circuit Court of Appeals, and this constituted the law of that District until reversed.

We conceive the law to be that, so long as a plaintiff is, in one or a series of cases, in good faith prosecuting his litigation *by the most expeditious line that is fairly open to him* under the statutes to obtain a determination as to the validity of his claim, he is under no present obligation to disclaim.

When the apparent invalidity of the claim is brought home to the patent owner by the decree of a court of competent jurisdiction or in other manner sufficient to overcome the presumption of validity attaching to the patent grant, an obligation to act promptly to save his patent is placed upon the patentee by the disclaimer statutes.

But just as soon as he passes by any opening available to him to litigate this issue to a conclusion, he is *breaking the continuity* of his effort and raising the question of the reasonableness of the delay.

Where more than one line of procedure presents itself for consideration, the patent owner must choose a line that involves no period of time during which he is not actively asserting the validity of the claim before a tribunal of competent jurisdiction whose decision will advance the final determination of the question by the court of last resort.

If, as in the instant case, he delays for two years while the accounting is in progress, and then, before final decree, files a disclaimer, a court is justified in holding, as in this case, that he has been guilty of unreasonable delay in filing the disclaimer, and is not entitled to maintain a suit on the patent under Rev. Stat. Section 4922.

It does not seem to us that *Silsby* vs. *Foote*, 61 U. S. 378 (1857), cited in the opposing brief, has any relevancy to the instant case. There the anticipating device had been held by the lower court, in the same case, to be destructive of claim 4 of the patent there in suit. The plaintiff had taken

the first opening to litigate his claim to validity. The plaintiff there had not unreasonably delayed at all. He had not passed by any opening or line by which he could have earlier litigated the issue on the declared invalid claim. This case was merely that of *O'Reilly* vs. *Morse, supra,* over again. There was delay—but it was not unreasonable.

The plaintiff here, relying on *O'Reilly* vs. *Morse, supra,* contends that he is under no obligation to proceed by the first open line, but may await the final decree before proceeding to litigate his claim in the highest court available to him.

As stated before, our contention is that *O'Reilly* vs. *Morse, supra,* merely decides that the plaintiff has the right *to go* to the highest court available before disclaiming—if he does not break the continuity of his effort.

But we say that plaintiff does break the continuity of his effort if he neglects to appeal from the interlocutory decree. The disclaimer statutes demand prompt action in order that there be no improper perseverance in excessive claim. The policy of these statutes requires promptness in disclaiming; and if plaintiff neglects to take the first opening to bring the issue before a reviewing court and continue along that line to its ultimate end, he is guilty of unreasonable delay and is not entitled to maintain his suit under Rev. Stat. Section 4922.

The principle at the basis of the above discussion is recognized in the case of *Mershon* vs. *Bay City Box Co.*, 189 Fed., 741, 753 (1910), where Judge Denison, in the Circuit Court, E. D. of Michigan, said:

> "We are confronted, then, by the rule that the patent was invalid, unless this claim is seasonably disclaimed in the Patent Office. It would seem that com-

plainant ought not to have any decree whatever on a patent which is *prima facie* invalid; but if this apparently logical rule was enforced and if complainant was required to disclaim a certain claim as a condition of having a favorable decree upon other claims, he would be obliged to accept the judgment of the trial court upon the claim found invalid, as final, and must file his disclaimer and lose his right of appeal upon that subject, or else, he must refuse to file the disclaimer, whereupon the entire bill must be dismissed; and while complainant could appeal from that decree, yet if the appellate court found that the action of the court below in requiring the disclaimer was right, the decree would be affirmed without considering the claims found valid below, and so complainant would lose the benefit of the valid claims. For these considerations, it seems to me clear that in such a case the usual interlocutory decree for injunction and accounting should be entered upon the valid claims and dismissing the bill as to the invalid claims, upon the theory that the failure to disclaim cannot be unreasonable until complainant has had an opportunity to litigate the validity of that claim to the court of last resort. This rule has been definitely adopted and announced by the Court of Appeals in the Second Circuit (*Page* v. *Dow*, 168 Fed. 703, 94 C. C. A. 209), and so far as I am aware, has been customarily followed in this circuit (*Plecker* v. *Poorman*, 147 Fed. 528, *Thompson, J.*).

"The difficulty cannot be met, in an interlocutory decree of this character, by providing that the complainant must, in the alternative, within the time limited, file disclaimer or take his appeal from that part of the decree dismissing the bill as to the invalid claim, because the complainant cannot appeal from that portion of such a decree. *In re National Enameling & Stamping Co.*, 201 U. S. 156, 26 Sup. Ct. 404, 50 L. Ed. 707.

* * * * *

"The difficulty here cannot be met by requiring, in the alternative, a disclaimer or an appeal by complainant within a limited time, because any provision along that line, fully worked out, would tend to affect the finality of the decree, and might destroy complainant's right of appeal.

"I see no way of preserving all rights except to proceed upon the assumption that the complainant is reasonably entitled to appeal, and that he will appeal, and that the eventual mandate of the Court of Appeals will properly dispose of the disclaimer question, leaving it with no present effect upon the decree of this court, except as to costs. If this assumption proves to be erroneous, and if the complainant rests content without an appeal or does not prosecute the appeal, the further action of this court upon that situation can be invoked by petition for rehearing, or review, or some proceeding of that general character."

It seems to us that Judge DENISON applied the rule for which the defendant here contends. In that case, and at that time, there was no appeal from an interlocutory decree. The Court recognized the logic of the rule that no recovery whatever should be had on a patent that is *prima facie* invalid. But because of the then limitations of the right of appeal, it was held not unreasonable to delay filing a disclaimer "until the complainant has had an opportunity to litigate the validity of that claim to the court of last resort."

We believe this to be the law. The patentee cannot be held to have delayed unreasonably until he has had the opportunity to take the question of validity to the court of last resort. But if he has that right and neglects it, then he has unreasonably delayed and neglected to disclaim under the statute, and has forfeited his right to further prosecute the suit.

Judge DENISON recognized the full significance of the interlocutory decree with and without the right of appeal therefrom. He properly decided that without the right of appeal from the interlocutory decree, there was no unreasonable delay in failing to disclaim promptly upon the entry thereof. We believe it is apparent that to Judge DENISON, it would have constituted unreasonable delay, if there had been the right of appeal at that time from such a decree and no appeal had been taken.

And in that opinion, Judge DENISON feels the logic of the principle contended for here by defendant to the extent that he suggests that the further action of the court could be invoked in that case in order to protect against unreasonable delay in filing the disclaimer, if and when such delay were made to appear.

We contend that under Section 4922 the suit cannot be *maintained* unless it appears that patentee has not unreasonably delayed in filing a disclaimer. Until that fact does affirmatively appear no recovery should be allowed or relief granted in any case.

The patentee is not entitled to the benefits of the statute, *i. e.*, he cannot *maintain* his suit, if he has unreasonably neglected or delayed to enter a disclaimer.

He may bring the suit and continue to prosecute it to the end. But at some stage before ultimate relief in the form of recovery is granted, it must appear that he has filed a disclaimer without unreasonable delay.

In the case of *Liquid Carbonic Co. et al.* vs. *Gilchrist Co.*, 253 Fed. 54 (C. C. A. 7th) 1918, ALSCHULER, *C. J.*, held:

> "Petition for modification of the order of this court directs attention to Sections 4917 and 4922, Rev. Stat. U. S., * * * and it is urged there should be no decree in appellee's favor under valid and infringed

claim 2 of the patent, unless claim 1, which we found to be void, was disclaimed as in these statutes provided, and that in no event is appellee entitled to recover any costs.

"That under the circumstances indicated in these statutes, *the benefit of any recovery* by the patentee *is denied unless or until disclaimer is filed*, and that he is entitled to recover no costs where disclaimer is not filed prior to the beginning of the suit, appears to be too well settled by the statutes and the decisions applying them to require further elucidation.

Sessions v. *Romadka*, 145 U. S. 29, 12 Sup. Ct. 799, 36 L. Ed. 609;

Gage v. *Herring*, 107 U. S. 640, 2 Supt. Ct. 819, 27 L. Ed. 601;

Seymour v. *McCormick*, 19 How. 96, 15 L. Ed. 557;

O'Reilly v. *Morse*, 15 How. 62, 14 L. Ed. 601;

Westinghouse v. *Cooper*, 245 Fed. 463, 157 C. C. A. 625;

Cummer & Son v. *Atlas Dryer Co.*, 193 Fed. 993, 113 C. C. A. 611;

Herman v. *Youngstown Car Co.*, 191 Fed. 579, 112 C. C. A. 185;

Novelty Glass Co. v. *Brookfield*, 172 Fed. 221, 97 C. C. A. 25;

Fairbanks, Morse & Co. v. *Stickney*, 123 Fed. 79, 59 C. C. A. 209;

Metallic Extraction Co. v. *Brown*, 110 Fed. 665, 49 C. C. A. 147.

"Claim 1, which we found void, is material and substantial, though it does not appear that the claim was made through 'any willful default or intent to defraud or mislead the public,' but rather 'through an inadvertence, accident or mistake.' No disclaimer of

it appearing to have been entered as in the statutes provided, but no unreasonable delay or neglect therein appearing, the order we heretofore made must be and is set aside, and in lieu thereof we make the following order:

"The decree of the District Court is reversed, and appellee shall have 60 days after mandate herein is filed in the district court, in which to file there a certified copy of disclaimer of claim 1 of the patent which disclaimer is to be entered in the United States Patent Office; and on the filing of such certified copy of disclaimer the District Court shall enter the usual decree for injunction and accounting under claim 2 of said patent, without costs to appellee. *Failing to enter and to file such disclaimer as prescribed, the bill shall be dismissed at appellee's costs.* Neither party shall recover costs of this appeal." (Italics ours.)

Disclaimer being an expeditious alternative to reissue, in the case of excessive claiming, the patentee is under obligation to disclaim at once on learning of the defect in his patent or to explain the delay. In the absence of explanation the delay of two years here, becomes unreasonable.

Where the defect appears by the interlocutory decree, the patentee may delay entering a disclaimer if he asserts his right to the excess by appeal from the interlocutory decree. But neither to disclaim nor to appeal leaves the public liable to the continuing assertion of property in an excessive claim during a period, which may run into as much as five years, in which the patentee alone can cause the question of validity of the disputed claims to be brought before the reviewing court.

The appeal statutes have been referred to in the opposing briefs as if the rights thereunder were absolute in all

respects. We contend that the disclaimer statutes are of equal status; and that the right to maintain this action is bottomed on the disclaimer statutes. The appeal statutes do not begin to function until it is shown that the disclaimer statutes have been complied with.

The right to appeal is dependent on the right to maintain the action. The right to maintain the action is dependent on the disclaimer statutes. The right to maintain the action may at any time be lost by forfeiture of the right to amend the patent through unreasonable delay.

So that unless the right to amend is exercised promptly, there is no continuing right to maintain the action, which means there is no absolute continuing right to appeal.

We submit that the entering of a disclaimer in this case was unreasonably delayed and that the case must be dismissed.

POINT II.

The plaintiff takes the position in Point II of his brief that the failure to file the disclaimer has nothing to do with the validity of claims 1, 3, 4 and 5; that it merely relates to costs.

This point was not before any of the courts dealing with any of the cases here for review. It is not properly before this court.

It is submitted, that, on reviewing a case on a writ of certiorari, errors not raised in the courts below will not be considered by the Supreme Court.

The law seems to be fully stated in the case of *Saltonstall* v. *Birtwell*, 164 U. S., 54, 41 L. Ed., 348, 1896, where

Mr. Justice SHIRAS in affirming the Circuit Court of Appeals said:

> "Nor do we consider it incumbent on us to consider whether there was error in the circuit court as a matter of practice, in directing judgment upon the special findings in favor of the importer. No such error was assigned in the circuit court, or was considered in the court of appeals, but it first appeared in the application for the writ of certiorari."

In the case of *New York Dock Co.* v. *The Steamship Poznan,* 274 U. S. 117, 71 L. Ed. 955 (1927), Mr. Justice STONE in refusing to consider questions raised for the first time in the Supreme Court, except to examine them to see that no obvious error was committed by the district court, said:

> "Respondent attempts to raise here questions with respect to the amount of recovery which were neither raised nor considered below. We have examined them only so far as is necessary to ascertain that no error was committed by the district court so plain or apparent as to warrant our consideration on such a state of the record."

For authority, the court cited numerous cases where the cause was before the court on writ of error and appeal, although this case was up on certiorari.

Cases before the court on writ of error or on writ of certiorari are treated alike. This position is sustained by the case of *Federal Trade Commission* v. *Pacific States Paper Trade Association,* and by the very words of the statutes authorizing review by writs of certiorari:

U. S. C. A., Title 28, sec. 347.

"* * * with the same power and authority and with like effect as if the case had been brought there by unrestricted writ of error or appeal."

In *Federal Trade Commission* v. *Pacific States Paper Trade Association*, 273 U. S. 52, 71 L. Ed. 534, 1927, it was held:

"Respondents, notwithstanding their failure to petition for certiorari, now ask for reversal of that part of the decree which leaves in force part of section (e) and sections (g) and (h). This court has the same power and authority as if the case had been carried here by appeal or writ of error. A party who has not sought review by appeal or writ of error will not be heard in an appellate court to question the correctness of the decree of the lower court. This is so well settled that citation is not necessary. The respondents are not entitled as of right to have that part of the decree reviewed."

11 Corpus Juris, 193—Certiorari; Section 343:

"C. Questions or Objections Not Raised Below. The rule applicable to appellate procedure generally, that objections not raised in the lower court cannot be relied on in the appellate court, governs the review on certiorari; and questions not raised below, or alleged erroneous action as to which no objection was made, cannot be presented to, or considered by, the reviewing court. Included within this rule are objections to the competency of witnesses, to the admissibility of evidence, that there was a failure of proof, or that there was a variance between the allegations and the proof. However, an exception to the judgment or decree is not necessary except when expressly required by statute. Where the errors complained of are jurisdictional, they will be considered, although not objected

to in the court below, although the contrary is held in Louisiana."

Consideration of Plaintiff's Point II.

In case this Court should decide to consider this Point II, we submit the following:

As we understand this point it is that, due to a change of language from that of Section 15 of the Patent Act of 1836 to that of Paragraph 4 of the Revised Statutes, Section 4920 (35 U. S. C. A., Section 69), it is now incumbent upon the defendant (under Paragraph 4), in order to sustain this defense, to prove that the patentee is not the inventor of *each and every* material and substantial part of the thing patented.

From this position, assumed without authority, the plaintiff argues (Plaintiff's Brief, p. 16) that a patent is not now void for excessive claiming, as it was under the law prior to the revision of 1872, and that, therefore (Plaintiff's Brief, p. 14), the disclaimer statutes are effective merely to provide the machinery for eliminating, of record, any excess in the claim; and to provide that no costs shall be recovered where the patent has been held invalid as to a substantial part thereof.

The plaintiff relies strongly upon *Sessions* vs. *Romadka* (1892), 145 U. S. 29, for support of this point.

We think it necessary only to read the passage quoted from this case, on page 9 of plaintiff's brief, to find that the holding was related solely to the case where the filing of the disclaimer was delayed *until after the commencement of the suit*. Under the exact language of the statute (Section 4922) this is so. It would seem unnecessary to argue the meaning of this case. It cannot stand for the proposition advanced by plaintiff.

It may be helpful, however, to quote from the decision in *Sessions* vs. *Romadka, supra,* for it does review the law and show that not only is plaintiff in error in his interpretation of the quoted passage, but the Court goes further and holds that there is no intended change in the meaning of these statutes since, in adopting the language of the Act of 1837, the legislature must be considered to have adopted the construction given thereto by the Courts.

Mr. Justice Brown said:

> "The only difficulty connected with the question of disclaimer in this case arises from the final sentence of Section 4917, that 'no such disclaimer shall affect any action pending at the time of its being filed except so far as may relate to the question of unreasonable neglect or delay in filing it.' There is an unfortunate choice of language here which has rendered this sentence very ambiguous and difficult of construction. It was held by Mr Justice Story in Reed *v.* Cutter, 1 Story, 590, 600, that if the disclaimer were filed during the pendency of the suit, the plaintiff would not be entitled to the benefit thereof in that suit—a ruling which had also been made in Wyeth *v.* Stone, 1 Story 273, 294. It was held in Tuck *v.* Bramhill, 6 Blatch. 95, that the provision meant that a suit pending when a disclaimer is filed is not to be affected by such filing, so as to prevent the plaintiff from recovering in it, *unless* it appears that the plaintiff unreasonably neglected or delayed to file the disclaimer. And such was also the ruling of Mr. Justice Nelson in Guyon *v.* Serrell, 1 Blatch. 244, and in Hall *v.* Wiles, 2 Blatch. 194, 198. We think that section 4917 ought to be read in connection with section 4922, providing that the patentee may maintain a suit at law or in equity for the infringement of any part of the thing patented, notwithstanding the specifications may embrace more than that of which the patentee was the first inventor or discoverer; but in every such case in

> which a judgment or decree shall be rendered for the plaintiff, no costs shall be recovered, unless the proper disclaimer has been entered at the Patent Office before the commencement of the suit. This was practically the construction given to corresponding sections of the Act of 1837 by this court in Smith *v.* Nichols, 88 U. S. 112 and of the Revised Statutes in Dunbar *v.* Myers, 94 U. S. 187. Under Section 4922 the effect of delaying a disclaimer *until after the commencement of the suit* goes only to the recovery of costs. We adhere to that construction. Congress having in the Revised Statutes adopted the language used in the Act of 1837 *must be considered to have adopted also the construction given by this court to this sentence, and made it a part of the enactment.*" (Italics ours.)

As will be seen from the foregoing, Mr. Justice Brown refused to accept the decision of Mr. Justice Story in *Reed* v. *Cutter* and in *Wyeth* v. *Stone*. He follows Mr. Justice Blatchford in *Tuck* v. *Bramhill*, wherein this very point is discussed and the conclusion reached that if the disclaimer is made after suit is brought, the plaintiff may recover, but without costs, *provided there has been no unreasonable delay in the filing of the disclaimer*. If there is unreasonable delay in the filing of the disclaimer, it can be set up as a defense to the whole action, and this comes under the last clause of Section 4922, whereas the matter of the denial of costs comes under the preceding provision.

In *Tuck* v. *Bramhill* (C. C., S. D. N. Y., Apr. 14, 1868), 24 Fed. Cas. 259, Mr. Justice Blatchford said:

> "It is provided, indeed, by the 9th section, that 'No person bringing any such suit shall be entitled to the benefit of the provisions contained in this section, who shall have unreasonably neglected or delayed to enter at the patent office a disclaimer, as aforesaid'. *It is*

not pretended, however, that the patentee in this case has been guilty of any such neglect or delay. It is further provided, by the 9th section, that, where the plaintiff recovers under that section, 'he shall not be entitled to recover costs against the defendant, unless he shall have entered at the patent office, *prior to the commencement of the suit*, a disclaimer of all that part of the thing patented which was so claimed without right'. Therefore, the plaintiff can recover no costs in this case.

But it is urged that the provision of section 7, that 'no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing the same', forbids a recovery by the plaintiff in this suit, notwithstanding the provisions of the 9th section. This is not so. It is true that Judge STORY, in Reed *v.* Cutter (Case No. 11,645), says, that if a disclaimer is filed during the pendency of a suit, the plaintiff will not be entitled to the benefit thereof in that suit; and that the same judge in Wyeth *v.* Stone (*Id.* 18,107), says, that the disclaimer mentioned in the 7th section, must be interpreted to apply solely to suits pending when the disclaimer is filed in the patent office, and the disclaimer mentioned in the 9th section to apply solely to suits brought after the disclaimer is so filed, and that the proviso to the 7th section, as to the disclaimer affecting a pending suit, prevents its affecting in any manner whatsoever a suit pending at the time it is filed. But the plaintiff does not need to claim any benefit in this suit from the disclaimer. *He recovers in this suit by virtue of the 9th section, it not appearing that he unreasonably neglected or delayed to enter a disclaimer.* I cannot concur, however, in Judge STORY's view of the provision in the 7th section, as to the disclaimer's affecting a pending suit. I understand that provision to mean, that a suit pend-

ing when the disclaimer is filed, is not to be affected by such filing, so as to prevent the plaintiff from recovering in it, *unless it appears that the plaintiff unreasonably neglected or delayed to file the disclaimer.* The 'unreasonable neglect or delay', mentioned in the 7th section, manifestly refers to the unreasonable neglect or delay mentioned in the 9th section, and the disclaimer mentioned in the 9th section is clearly the disclaimer provided for in the 7th section. Moreover, the provision of the 9th section, that the plaintiff, where he is entitled to recover under that section, shall not recover costs, unless he has entered a disclaimer, prior to the commencement of the suit, of what he claimed without right, is a strong implication, that, where he does not enter the disclaimer until after the commencement of the suit, he may still recover in the suit, *if otherwise entitled to do so*, but without recovering costs. And such has been the view heretofore held by Mr. Justice NELSON, in this court. In Guyon *v.* Serrell (Case No. 5,881), he allowed a recovery, without costs, in a case where a disclaimer was filed after suit brought; and in Hall *v.* Wiles (*Id.* 5,954), he says: 'If the disclaimer was entered in the patent office before the suit was instituted, the plaintiff recovers costs in the usual way, independently of any question of disclaimer. But if, in the progress of the trial, it turns out that a disclaimer ought to have been made as to part of what is claimed, the plaintiff may recover, but will not be entitled to costs.' Of course, it follows, that if a disclaimer is made after suit brought, the plaintiff may still recover, but without costs." (Italics ours.)

In plaintiff's brief, he quotes from *Sessions* v. *Romadka*, and italicizes the language:

"Under section 4922 the effect of delaying a disclaimer until after the commencement of the suit

goes only to the recovery of costs. We adhere to that construction."

The Court had previously said that the two sections must be read together and that the language of Section 4917 ("No such disclaimer shall affect any action pending at the time of its being filed except so far as may relate to the question of unreasonable neglect or delay in filing it") meant that a suit pending when a disclaimer is filed is not to be affected by such filing so as to prevent the plaintiff from a recovery *unless* he has neglected or delayed to file a disclaimer. When Mr. Justice BROWN said, in the excerpt quoted by plaintiff, that he adhered to the construction that "under Section 4922, the effect of delaying a disclaimer until after the commencement of the suit goes only to the recovery of costs", he was emphasizing the delay in filing the disclaimer *until after the commencement of suit.* In other words, if you delay, either reasonably or unreasonably, in the filing of the disclaimer *until after* the commencement of the suit, you cannot recover costs. You can have damages if there is no unreasonable delay. On the other hand, if you unreasonably delay, under section 4917, as well as under section 4922, this fact becomes a defense that can be pleaded to the whole action, and if the defense is sustained, the patentee can recover *neither* damages nor costs.

In the case of *Hall* v. *Wiles*, 2 Blatch. 194; 1 Fish Pat. Rep. 433 (C. C., S. D. N. Y., Apr. 17, 1851), Case No. 5,954, 11 Fed. Cas., p. 280, NELSON, Circuit Justice, said:

> "It is argued by the defendant that, in order to have saved the patent, the patentee should have disclaimed this part of his patent, under the 7th and 9th sections of the Act of March 3, 1837 (5 Stat. 193, 194)

and that, as he has failed to make this disclaimer and to record it, this suit cannot be maintained and the whole patent is void. Though there is some evidence going to show that this contrivance may be new, and may not have been used before, yet, perhaps, the weight of it is that it is useless or could not be operated. I have examined the provisions of the statute, and am of opinion that this suit may be maintained, under the two sections referred to, notwithstanding a disclaimer of the first claim has not been made or recorded; but the plaintiff will not be entitled to costs. The provision in the 9th section, that *no costs* shall be recovered *unless* a *disclaimer* of all that part of the thing patented which is claimed without right, *is entered before the commencement of the suit*, certainly shows that the action may be maintained for other parts of what is patented. If the disclaimer was entered in the patent office before the suit was instituted, the plaintiff recovers costs in the usual way, independently of any question of disclaimer. But if, in the progress of the trial, it turns out that a disclaimer ought to have been made as to part of what is claimed, the plaintiff may recover, but will not be entitled to costs.

"*Another question arises under the 9th section—whether there has been unreasonable negligence or delay in entering a disclaimer. That is a question which goes to the right of action. If the delay shows great negligence, the jury may say that the patent is void.* The provision in question applies only to the case where the part claimed by the patentee, of which he is not the inventor, is a material and substantial part of the thing patented. A disclaimer is necessary, therefore, only where the thing claimed without right is a material and substantial part of the machine invented. The question as to the disclaimer in this case is, therefore, of no importance in the determination of the rights of the parties, unless the slides and springs claimed in

> the first claim are described as a material and essential part of the machine, or unless they were introduced into the description through the wilful default of the plaintiff, or with intent to defraud or mislead the public. If you find that these slides and springs are not essential to the machine, and were not introduced into the patent through such wilful default or intent to defraud or mislead the public, the want of a disclaimer in regard to them affords no ground for invalidating the patent."

The corollary of this is that if the slides and springs are essential, then the want of a disclaimer *does* afford ground for invalidating the patent. As the Court says:

> "That is a question which goes to the right of action. If the delay shows great negligence, the jury may say that the patent is void."

That is to say, in this case it was held that the unreasonable delay might defeat the right to recovery, as well as the right to costs under Section 9 of the Act of 1837.

Mr. Justice BROWN, in *Sessions* v. *Romadka, supra*, held that in adopting the language of Section 9 of the Act of 1837, in the Revised Statutes, Section 4922, Congress had given the construction given to that language theretofore by the Courts. We contend, therefore, that under Section 4922, this case of *Hall* vs. *Wiles* applies and is the law today.

In *Smith* vs. *Nichols*, 88 U. S. 112, 22 L. Ed. 566 (1874), Mr. Justice SWAYNE said:

> "It is objected that the disclaimers having been made after the filing of the complainants' bill, cannot avail him in this case. Upon a fair construction of the 7th and 9th sections of the Act of 1837, we think they could be made as well after as before the commencement of the suit. It would in such case be the duty

> of the court to see that the defendant was not injuriously surprised, and to impose such terms as right and justice might require. *The question of unreasonable delay would be open for the consideration of the court,* and the complainant could recover no costs. We see no reason for turning a party out of court to renew the litigation after filing the disclaimer, thus subjecting both parties to the delay and expense which must necessarily follow, and without any benefit to either. We cannot believe such to have been the intention of Congress. Tuck *v.* Bramhill, 6 Blatch. 104; Silsby *v.* Foote, 14 How. 220; Aikin *v.* Dolan, 3 Fish. 197; Taylor *v.* Archer, 8 Blatch. 315; Guyon *v.* Serrell, 1 Blatch. 244; Hall *v.* Wiles, 2 Blatch. 194." (Italics ours.)

It seems to us that the court is here saying that where the disclaimer is not filed before suit, no costs shall be recovered, and that, in addition, there would be open for the consideration of the court, the question of unreasonable delay. If it appears at any time during the trial that there has been unreasonable delay in filing a disclaimer, the plaintiff has lost the right to amend his patent; it is wholly void. And there is no right to further prosecute the suit. (See discussion of *Minerals Separation* vs. *Butte*, 250 U. S., this Brief, page 39.)

Plaintiff quotes (Plaintiff's Brief pp. 9-10) from the case of *Hailes* vs. *Albany* (1887), 123 U. S. 582, and we adopt this quotation as our own. Referring to the two sections of the disclaimer statute (Rev. Stat. 4917 and 4922), Mr. Justice Bradley says:

> "One section authorizes a disclaimer to be filed in certain cases; the other enables patentees to maintain suits in those cases, provided a disclaimer is filed without unreasonable delay."

The Court then goes on to say that these sections enable one to obviate the hardships of the common law

> "which made a patent *wholly void if any part of the invention was wrongfully claimed* by the patentee, and which made such a defect in a patent an effectual bar to a suit brought upon it."

There is no suggestion here that one could obviate the hardships of the common law except by compliance with the disclaimer statutes referred to. According to Mr. Justice BRADLEY, one of the sections (Section 4922) enabled patentees to maintain suits in such cases as are described in the other section (Section 4917) provided a disclaimer is filed without unreasonable delay. The conclusion is unescapable that if the disclaimer is not so filed, the hardships of the common law still prevail, and the quoted defect is still an effectual bar to a suit brought upon the patent.

In this connection, Robinson says (*Robinson on Patents*, Vol. 2, Sec. 651, p. 291):

> "The act of 1837 * * * enacted that the plaintiff claiming under such a patent should be entitled to maintain his suit * * * *if the right to amend the patent by disclaimer had not been already forfeited by an unreasonable delay* * * *." (Italics ours.)

But, says plaintiff: The law has been changed. It is *now* necessary for defendant, in order to sustain the defense of paragraph 4, Section 4920, to prove that no single part of the thing patented was the act of the patentee, and that, therefore, there is no such thing as excessive claiming in the patent law today. Plaintiff cites no authority for this position, but relies upon argument based upon the change in language in Paragraph 4, Rev. Stat., Section 4920.

The language of Section 15 of the Act of 1836 is:

> "That the defendant * * * shall be permitted * * * to give * * * any special matter in evidence tending to prove * * * that the patentee was not the original and first inventor or discoverer of the thing patented, *or of a* substantial and material part thereof claimed as new, * * *."

Revised Statutes, Section 4920 (U. S. C. A., Section 69, Title 35) provides that

> "* * * the defendant may plead, * * * and, having given notice, * * * may prove on trial * * *"
>
> "Fourth. That he (the patentee) was not the original and first inventor or discoverer *of any* material or substantial part of the thing patented." (Italics ours.)

It would seem to be the contention of plaintiff that from this change in language and from the fact that the American courts early adopted the contract theory of patent, the defect of excessive claiming is wiped out of our patent system, and that under Section 4920, Par. 4, the defendant must prove in order to sustain that defense that the plaintiff did not invent any single part of the claimed invention.

Plaintiff refers (Plaintiff's Brief, p. 19) to Robinson on Patents, Vol. 1, p. 60, Sec. 41 (Ed. 1890) as supporting this view. We see no such support. On the contrary.

In Section 42, Robinson says:

> "* * * the obligation of the inventor * * * is two-fold:
>
> (1) The result of his inventive skill must be of such nature that a patent may lawfully be granted to protect it;

(2) The invention itself must be fully communicated to the public. Of these two obligations the latter is practically the most important."

Again, in the same section, on p. 63, he says:

"Through the whole body of the law runs the same principle that the real consideration given to the public for the patent privilege is not the skill of the inventor in inventing, but his honesty and thoroughness in making his discovery known."

It would seem to be clear that the contract theory, far from relieving the patentee of the necessity of accurate disclosure and claim, and of the disastrous effect of excessive claiming, actually stresses his obligation to the greatest accuracy and thoroughness in disclosure and claims.

If by accident or mistake, the patentee claims too much, he should be allowed to withdraw the excess. But always in accordance with law. If he does not disclaim the excess in accordance with law, his contract is void. *Robinson on Patents*, Vol. 2, Sec. 651, p. 290.

Unless the plaintiff can spell some change in this policy out of the change in language in Paragraph Fourth of Section 4922, there would seem to be no such different policy.

The language in Section 15 of Act of 1836 is

"* * * of the thing patented *or of a* substantial and material part thereof claimed as new."

Paragraph 4, Section 69, Title 35:

"* * * *of any* material and substantial part of the thing patented."

It should be noted in this connection that the language of Section 9 of Act of 1837 (first disclaimer statute), relating to the excess, was "of any material or substantial part of the thing patented". And the same language is retained in Revised Statute Section 4922.

Paraphrasing Section 15, Act of 1836, it provides:

> that the defendant shall be permitted, on notice, to plead and put in evidence any special matter tending to prove that the patentee was not the original and first inventor of the thing patented, or of a substantial and material part thereof claimed as new.

This, it seems to us, means that the defense is made out if it is shown that the patentee was not the inventor of any one of several material parts of the thing patented.

Section 4922, likewise paraphrased, provides:

> that the defendant, on notice, may plead and prove that the patentee was not the inventor of any material part of the thing patented.

This likewise means that the defense is satisfied if it is shown that any one of several material parts of the thing patented was not the invention of the plaintiff.

Certainly there is no direct authority quoted by plaintiff to the contrary. And courts are daily holding, under the present law, that once a claim is definitely found to be invalid, there is the necessity of prompt disclaimer; otherwise the plaintiff is without the right to maintain his suit.

In the case of *Minerals Separation* vs. *Butte* (250 U. S. 353) the respondents contended that

> "* * * the disclaimer filed by the petitioners with respect to the three claims held invalid by the decision of this court in the former case was so delayed and is so evasive in form that it is invalid, and that, for this

reason, the petitioners should not be permitted to *further prosecute* this suit, under the provisions of Rev. Stat. Secs. 4917, 4922, Comp. Stat. 1916, Secs. 9462, 9468, 7 Fed. Stat. Anno. 2d ed., pp. 231, 372." (Italics ours.)

The Court said:

"The decision holding the three claims invalid was rendered on December 11th, 1916, and the disclaimer was recorded on the 28th day of March, 1917. Having regard to the fact that the owners of the patent in suit resided in a foreign country, and to the war-time conditions of communication then prevailing, the entry required by law was not 'unreasonably neglected or delayed'. While the wording of the disclaimer borders on finesse, we do not think it can be interpreted as giving any rights under the patent greater than may be legitimately obtained under the claims held valid, and we therefore deem it sufficient to meet the requirements of the statutes cited."

It will be seen that this was a direct attack, based on the disclaimer statutes, on the right to *further prosecute* the Butte suit. This Court, in this case, apparently considered that if the delay was unreasonable, it would defeat the right to further prosecute the suit. Consequently, it examined into the reasonableness of the delay and came to the conclusion that it was not unreasonable. This decision was rendered in 1919, and is quite consistent with every case examined by defendant's counsel including all those cited in the opposing briefs. The reasonableness of the delay goes to the right to maintain the action, and it is always open to the consideration of the Court.

In view of the statement of the Court in *Sessions* vs. *Romadka* that the Congress must be considered to have

adopted the construction put on the language of the earlier statutes by the Courts, in re-enacting that language in the Revised Statutes, and in the absence of some direct authority to the contrary, we submit that this Point II is not well taken, even if properly before the Court.

The decree of the Court below should be affirmed.

Respectfully submitted,

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